



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,877	01/02/2001	Gerhard Hoefle	2727-127	5629

7590 03/21/2002

RONALD R. SANTUCCI
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE
NEW YORK, NY 10151

EXAMINER

AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 03/21/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/674,877

Applicant(s)

Hoefle, G. et al.

Examiner

CHARANJIT AULAKH

Art Unit

1625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 18-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 4, 5, 18-20, and 22 is/are allowed.
- 6) ☒ Claim(s) 3, 6-14, 23, and 24 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1625

DETAILED ACTION

1. According to paper no. 7 filed on Jan. 30, 2002, the applicants have canceled claims 15-17, amended claims 2, 3, 6-14 and furthermore, have added new claims 18-24.
2. Claims 1-14 and 18-24 are now pending in the application.

Response to Arguments

3. Applicant's arguments filed on Jan. 30, 2002 (paper no. 7) have been fully considered but they are not persuasive regarding Claim objections and indefiniteness rejections. The examiner agrees with the applicant's arguments regarding prior art rejections. It is of note that the applicants have amended claims to overcome some but not all of the indefiniteness rejections. First of all, regarding objection of multiple dependent claims 9-14, the examiner does not agree with the applicants arguments that these claims are in proper form. Claims 9-14 are dependent upon claim 1 and claim 1 discloses compounds of formula (2) only . Compounds of formula (3) are disclosed in claim 2, compounds of formula (4) are disclosed in claim 3, compounds of formula (5) are disclosed in claim 4 while compounds of formula (6) are disclosed in claim 5. Therefore, these claims are in improper form since a multiple dependent claim should refer to other claims in alternate and furthermore, these claims are indefinite since various compounds of formula (3), (4), (5) or (6) are neither disclosed in claims 9-14 nor claim 1. In regard to indefiniteness rejection of claim 3, the applicants have not amended claims to delete the term--- especially --.

Art Unit: 1625

In claim 3, the applicants are suggested to delete ---- especially Br or I----.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 6-8, 12, 23 and 24 recite the broad recitation C1-6-alkyl group etc., and the claim also recites especially C1-4-alkyl etc. which is the narrower statement of the range/limitation.

Art Unit: 1625

In claim 6, the applicants are suggested to delete ----, especially a C1-6-alkyl group-----.

In claims 7 and 23, the applicants are suggested to delete ---,especially C1-4-alkyl, C2-4-alkenyl and C2-4-alkinyl groups, respectively and the halogen atoms----- since F, Cl, Br and I are the only known halogens.

In claims 8 and 24, the applicants are suggested to delete ---and especially 1, 2, 3 or 4 ----.

In claim 12, the applicants are suggested to delete ---,especially a C1-4-alkyl group, preferably a methyl, ethyl, propyl or butyl group-----.

Claim 21 appears to be a substantial duplicate of claim 4.

6. Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 9-14, the compounds of formula (3), (4), (5) or (6) are neither disclosed in these claims nor claim 1 from which they depend upon.

Art Unit: 1625

Conclusion

7. Rejection of claims 4,5, 7 and 8 under 35 U.S.C. 102(b) is withdrawn.
8. Objection of claims 9-14 is maintained for the reasons of record.
9. Rejection of claim 3 under 35 U.S.C. 112, second paragraph is maintained for the reasons of record.
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

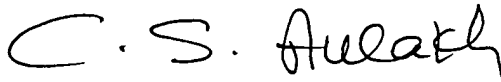
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chana Aulakh whose telephone number is (703) 305-4482. The examiner can normally be reached on “ Monday-Thursday “ from 7:30 A.M. to 6:00 P.M.

Art Unit: 1625

If the attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Alan Rotman, can be reached on (703) 308-4698. The fax number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group's receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read "C. S. Aulakh". The signature is fluid and cursive, with the first letters of each name being capitalized and prominent.

CHARANJIT S. AULAKH

PRIMARY EXAMINER